

REMARKS

Applicants thank Examiner Valenrod for the review of the pending application. Claims 1, 6-7, 12-19 are currently amended. Claims 6-11, 17 and 18 are withdrawn. Claims 1-19 are currently pending. By way of this amendment, no new matter is added.

Claim Objections

The Examiner has objected to claims 12-16 and 19 for improper form or spelling errors. Applicants have followed the Examiner's suggestions and made the appropriate corrections. These changes are reflected in the claims listing above. Applicants believe that these claim objections are now obsolete and respectfully request their withdrawal.

35 U.S.C. § 112 Rejections

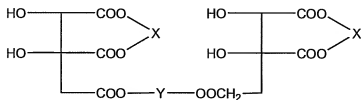
Claims 3-5, 12-16 and 19 are rejected under 35 U.S.C. § 112 as lacking proper antecedent basis for the limitation "HCA" in these claims. Applicants have amended claim 1 to include the abbreviation "(HCA)" after the term "(–)-hydroxycitric acid" to provide proper antecedent basis. Accordingly, Applicants respectfully request withdrawal of this rejection.

35 U.S.C. § 102(b) Rejections

Claims 1, 2, 5 and 19 are rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 6,221,901 to Shrivastava et al. ("Shrivastava"). Applicants respectfully traverse this rejection.

Independent claim 1 recites,

"Double salts of (–)-hydroxycitric acid (HCA) as shown in the general formula I



(I),

wherein X and Y are independently selected from metals of group II (IIA & IIB) of the Periodic Table."

Shrivastava does not disclose each and every claim limitation as recited in the claims, such as the double salt compound. Instead, Shrivastava discloses the composition and a process for the preparation of magnesium (-)-hydroxycitrate. (Shrivastava, Col. 2, lines 9-23).

To constitute anticipation of the claimed invention under 35 U.S.C. § 102, the prior art reference must expressly or inherently disclose each and every limitation of the claims. Here, the Examiner argues that the claims are anticipated because Shrivastava inherently discloses that the ingredients required to make the claimed double salt compound are present in the solution. However, the Examiner has not provided "*objective evidence or cogent technical reasoning to support the conclusion of inherency.*" See MPEP 2112, Subsection IV, citing *Ex parte Levy*, 17 USPQ2d 1461 (Bd. Pat. App. & Inter. 1990). Nor has the Examiner provided support for the assertion that a double salt compound would "*necessarily*" flow from the teachings of the applied prior art. *Id.* Accordingly, withdrawal of this rejection is respectfully requested for claim 1.

Further, because claims 2, 5 and 19 directly depend from claim 1, Shrivastava does not anticipate these claims either. Applicants respectfully request withdrawal of this rejection.

35 U.S.C. § 103(a) Rejections

Claims 1-5, 12-16 and 19 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shrivastava. Here, the Examiner has restated the inherency argument; however, the Examiner still has not provided objective evidence or cogent technical reasoning to support the conclusion of inherency. Nor has the Examiner provided support for the assertion that a double salt compound would necessarily flow from the teachings of the applied prior art.

Additionally, the Examiner argues that the claims are obvious because one of ordinary skill in the art would be motivated to make variations of a hydroxycitric acid in order to alter the solubility of the acid. The Examiner appears to be arguing that it would be obvious to make a double salt to arrive at the claimed double salt compounds. This rationale fails under the law of KSR. (*KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1397 (2007)). This is because an obvious-to-try rationale can only support a rejection under § 103 in the limited situations where there "are a

finite number of identified, predictable solutions, [and] a person of ordinary skill has good reason to pursue the known options within his or her technical grasp.” *Id.*

However, this is not a predictable art with a finite number of predictable solutions. In fact, as admitted by the Examiner, “altering the counter ion of a carboxylic acid salt can have a profound effect on the physical properties of that salt.” (Office Action, page 5). Thus, one of skill in this art would have no reason to modify the teachings of Shrivastava, which does not disclose any activity relating to osteoporosis, to arrive at the claimed double salt compound which has been discovered to have utility in the treatment in osteoporosis. Accordingly, claim 1 is not obvious over the cited reference. Claims 2-5 and 12-19 depend from claim 1, so they cannot be rendered obvious over the cited reference for at least the reasons mentioned above. Thus, withdrawal of this rejection is respectfully requested.

CONCLUSION

Applicants believe that any fee due with this response is identified in an accompanying transmittal. However, if any additional fee is due, please charge our Deposit Account No. 18-0013, under Order No. DAD-0013 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to such deposit account number.

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Respectfully submitted,

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